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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,429

11/17/2003

Kelly E. Rollin

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

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DELIVERY MODE

12/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/713,429

**Applicant(s)**

ROLLIN ET AL.

**Examiner**

Etienne P. LeRoux

**Art Unit**

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Status***

Claims 28-63 are pending. Claims 28-63 are rejected as detailed below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39, 51 and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 39 states “if there is not sufficient memory available on the PSD to store a user profile, selecting a portion of memory on the PSD for storing the user profile.” A skilled artisan would not be able to make and use the claimed invention because above limitation is contradictory. No art rejection of above limitation is provided. Claims 51 and 63 include similar language to the above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28, 40 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,262,730 (Horvitz et al), hereafter Horvitz.

Claims 28, 40 and 52:

Horvitz discloses:

upon detecting a connection of a Portable Storage Device (PSD) to a computing device [Fig 1, 10, col 6, line 45, handheld device, new user detected step 140, Fig 11]

in response to detecting that no existing user profile is found, automatically launching a user profile configuration wizard [Fig 11, col 17, line 55 through col 18, line 15, profile access routine asks the user for permission to enter a user competency dialog with the user, step 144, Fig 11]

Note:

Automatic launching is not included in the specification, therefore automatic launching<sup>1</sup> is interpreted: To activate an application program from the operating system's user interface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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<sup>1</sup> Microsoft Computer Dictionary, Fifth Edition.

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-38, 41-50 and 53-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz in view of US Pat No 6,505,215 (Kruglikov et al), hereafter Kruglikov.

Claims 29, 41 and 53:

Horvitz discloses the elements of claim 28 as noted above but does not disclose wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device. Kruglikov discloses wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device [col 2, line 35-37]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horvitz to include wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device as taught by Kruglikov for the purpose of coordinating the data in different calendars [col 2, lines 35-40] .

Claims 30, 42 and 54:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses wherein the content data comprises a plurality of different types of data [Kruglikov, personal contact and calendar, col 8, line 28]

Claims 31, 43 and 55:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses wherein the plurality of different types of data include one or more of

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contacts, multimedia files, calendar data and documents [Kruglikov, personal contact and calendar, col 8, line 28]

Claims 32, 44 and 56:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses wherein for each of the plurality of types of data, the user may select all, some, or none of the data [Kruglikov, col 2, lines 30-45]

Claims 33, 45 and 57:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses wherein the step of synchronizing the selected content data with data on a later-connected PSD [Kruglikov, col 2, lines 30-45]

Claims 34, 35, 46, 47, 58 and 59:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses wherein the content data comprises user settings [Horvitz, user permission, col 18, lines 8-10]

Note:

Above is examiner's best interpretation because user settings are not included in the specification

Claims 36, 37, 48, 49, 60 and 61

The combination of Horvitz and Kruglikov discloses the claim elements as noted above and furthermore discloses the step of displaying, if the user chooses some of the user settings for synchronization , a list of user settings to the user [Kruglikov, Figs 5A, 5B and 6]

Claims 38, 50 and 62:

The combination of Horvitz and Kruglikov discloses the claim elements as noted above but does not disclose determining if sufficient memory is available. Official Notice is taken that determining if sufficient memory is available is well-known and expected in the art because attempting store data into memory which is too small may cause a system crash.

Note:

Above is examiner's best interpretation of the claim limitation because there is no antecedent basis for the claim limitation in the specification.

***Response to Arguments***

Applicant's arguments filed 2/5/2007 are moot based on above new grounds of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

2/28/2007

  
ETIENNE LEROUX  
PRIMARY EXAMINER